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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,746	12/21/2001	James Hongxue Wang	KCC-15,796	3698

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EXAMINER

KIDWELL, MICHELE M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/036,746

**Applicant(s)**

WANG ET AL.

**Examiner**

Michele Kidwell

**Art Unit**

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-116 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8-11, 13, 14, 17-22, 25-30, 32-34, 41, 45-60, 63, 65, 67-71, 75, 76, 78-80 and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/9/02; 1/8/04</u>   | 6) <input type="checkbox"/> Other: _____                                    |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4,5,7-12,15,16,23,24,31,35-40,61,62,64,66,72-74,77,81-86 and 88-116.

## DETAILED ACTION

### *Election/Restrictions*

The examiner acknowledges the applicant's remarks filed November 8, 2004 regarding the unintentional typographical error made by applicant on page 34 of the Preliminary Amendment dated July 6, 2004. Accordingly:

Claims 4 – 5, 7, 12, 15 – 16, 23 – 24, 31, 35 – 40, 61 – 62, 64, 66, 72 – 74, 77, 81 – 86, 91, 96, 99 – 100, 105 and 110 – 115 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 8, 2004.

Claims 88 – 90 and 92 – 95 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

In the election dated July 9, 2004, the applicant elected figure 1.

Figure 1 does not include an absorbent core adjacent a surge material as claimed in independent claim 88 and therefore claims 88 – 90 and 92 – 95 are not readable on the elected figure and have been withdrawn from further consideration.

Claims 97 – 116 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

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While independent claim 97 has been amended to include all of the limitations of claim 1, the examiner continues to find claim 97 as patentably distinct from claim 1 because the inventions are related as process of making and product made. The product (claim 1) can be made by another and materially different process such as without printing the superabsorbent precursor material onto the surge material, drying the superabsorbent precursor and crosslinking the superabsorbent precursor.

This application contains claims 4 – 5, 7, 12, 15 – 16, 23 – 24, 31, 35 – 40, 61 – 62, 64, 66, 72 – 74, 77, 81 – 86, and 88 – 116 drawn to a nonelected species and invention

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 3, 6, 8 – 11, 13 – 14, 17 – 22, 25 – 30, 32 – 34, 41, 45 – 60, 63, 65, 67 – 71, 75 – 76, 78 – 80 and 87 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanzer et al. (US 6,429,350)

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With reference to claim 1, Tanzer et al. (hereinafter "Tanzer") discloses an absorbent article comprising a liquid permeable body-side liner, a surge composite adjacent to the body-side liner, the surge composite comprising a non-absorbent wettable fibrous surge material, a plurality of discrete regions in the surge material; and a superabsorbent material bonded to the fibers in at least some of the regions; and a substantially liquid-impermeable outer cover adjacent to the surge material on a side opposite the body-side liner as set forth in col. 2, lines 45 – 48; col. 6, lines 28 – 30 and in the figures.

As to claims 2 and 58 – 59, Tanzer discloses the surge material as a treated non-absorbent hydrophobic fibrous material as set forth in col. 6, lines 28 – 49.

With reference to claims 3 and 60, Tanzer inherently discloses the claimed surface area as shown in figure 6. The figure shows the discrete region with the surface area comprising at least about 80%.

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With respect to claims 6, 11, 63 and 65, Tanzer at least one of the plurality of discrete regions to extend through a length of the thickness of the surge material, which would inherently include about 10 to about 95% of the length, as set forth in col. 4, lines 29 – 36.

As to claims 8 – 10, see col. 4, lines 29 – 36.

Regarding claims 13 – 14, see col. 5, lines 39 – 47.

With reference to claims 17 – 22, 26, 32 – 34, 45 – 47, 68 – 71, 76 and 78 – 80, these limitations are considered product by process limitations and only the end structure is given patentable weight. Tanzer discloses the end structure that the product by process limitation results in. The applicant is reminded that:

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

With reference to claims 25 and 75, see col. 6, lines 34 – 49.

As to claim 27, see col. 4, lines 37 – 42.

With respect to claims 28 – 30, see col. 5, lines 13 – 16.

Regarding claims 41 and 87, see col. 4, line 60 to col. 5, line 12.

With reference to claims 48 – 50, see col. 8, lines 35 – 42.

As to claims 51 – 56, see col. 8, lines 26 – 34.

With reference to claim 57, see the rejection of claim 1.

As to claim 67, see the figures.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday - Friday, 5:30am - 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 571-272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michele Kidwell  
Examiner  
Art Unit 3761